

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Albert BAUER Conf. no. 2665
Serial No.: 08/998,507 Group Art Unit: 3743
Filed: December 26, 1997 Examiner: John Ford
For: AIR CONDITIONING APPARATUS

Commissioner for Patents
Washington, DC 20231

REPLY BRIEF

Sir:

This is a Reply to the Examiners' letter mailed on March 12, 2007.

Examiner Ford takes issue with the applicants' submission of a Reply Brief in response to the "miscellaneous letter" mailed by Examiner Ford on January 9, 2007.

The decision issued by the Board on October 31, 2007 was a remand to the examiner pursuant to 37 CFR 41.50(a)(1). The Board left two options to the examiner: reopen prosecution by issuing a new rejection under 35 USC 112, second paragraph or "If the rejections are maintained, the examiner must identify the structure of Johannsen that meets the 'means for regulating...' ". (emphasis added) The Board also stated that "37 CFR 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board."

37 CFR 41.50(a)(2) states:

"(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) Reopen prosecution. ... (ii) Maintain appeal. Request that the appeal be maintained by filing a reply brief as provided in § 41.41. ...”

There is no provision in the Rules for an Examiner to submit a “miscellaneous letter” in response to a Remand, as Examiner Ford contends. These proceedings are governed by the Rules of practice, and lack of the appropriate heading cannot control a filing in this proceeding. Examiner Ford’s “miscellaneous letter” was clearly directed to maintaining the rejections of record, and while specific to concerns voiced by the Board, under the Rules must be considered a Supplemental Examiners’ Answer.

The applicant could not ignore the “miscellaneous letter”. To do so would risk a sua sponte dismissal of the appeal. The filing of a reply brief was not improper; it was required by the Rules.

In view of the above, it is requested that the Examiners’ second miscellaneous letter be disregarded by the Board.

Respectfully submitted,

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